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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,285	04/04/2001	Raymond John Herbert	5006	4054
26936	7590	05/02/2006	EXAMINER	
SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,285

Applicant(s)

HERBERT, RAYMOND JOHN

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 3-9 have been examined.

Response to Arguments

2. Applicant is of the opinion that the prior art fails to teach “processing means that scans not the identifier printed by printing means but rather existing indicia which are separate and unrelated to the printed identifier” (Response, 3-2-06, page 2, first paragraph). However, the claims are absent what Applicant regards as distinguishing subject matter. It has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). Therefore, the Examiner maintains the rejection as the prior art of O’Callaghan et al. and Michael et al. continue to read on the claims as they are written.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 3-6 and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by O'Callaghan et al., U.S. Patent No. 6,311,892.

As per claims 3-5, O'Callaghan et al. teach a method and apparatus for imprinting postal indicia on mailpieces comprising: the utilization of a sensor to scan an indicium (that includes cryptographic data, and data in machine readable, 2-D, or matrix form) with a barcode and generating an indication of a presence of the imprint of the postal indicium (column 2, lines 5-17 and 35-47; column/line 2/65-3/14; column 4, lines 50-57; column 9, lines 62-65) in response to scanning a barcode (figures 2 and 4; column 1, lines 14-23; column 2, lines 23-31; column 4, lines 27-63; column 5, lines 4-37; column 6, lines 55-62; column 7, lines 5-17; column 8, lines 25-31).

As per claim 6, the mailpieces of O'Callaghan et al. include postage indicium (column 2, lines 5-17), therefore, it is inherent that at some juncture the mailpieces were "fed" to an apparatus in order to apply or print said indicium.

As per claim 8, O'Callaghan also teach after scanning a barcode, generating an indication of the barcode and generating a second signal indicative of a postal indicium imprint on the mailpiece (figure 4; column 4, lines 28-62; column 5, lines 4-37; column 6, lines 55-62; column 7, lines 10-15; column 8, lines 25-31).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Callaghan et al., U.S. Patent No. 6,311,892 in view of Michael et al. U.S. Patent No. 4,141,492.

As per claim 7, O'Callaghan et al. teach a method and system for verifying articles using postage indicia (abstract). Specifically, O'Callaghan et al. teach by passing mailpieces along a conveyor to a scanner for verification (figures 1 and 2) and recording the results of said verification (column 4, lines 27-41; column 7, lines 5-17). However, O'Callaghan et al. do not specifically recite stopping the flow of mailpieces if an indicia is not detected. Michael et al. teach stopping the

flow of indicia for verification if an error is detected (column 2, lines 27-44).

Therefore, it would have been obvious to one of ordinary skill to combine the teachings of O'Callaghan et al. and Michael et al. in order to prevent further errors from being introduced into the system (e.g. mailpieces lacking or with improper indicia).

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Callaghan et al., U.S. Patent No. 6,311,892.

As per claim 9, O'Callaghan et al. teach an apparatus (figures 1 and 2) for verifying indicia comprising a transporter to feed mailpieces to a verification station (abstract; figures 1 and 2). However, O'Callaghan et al. do not specifically recite a method for the process using a counter. Branecky et al. teach a process and apparatus for controlling the flow of mailpieces on a transport means using a counter (abstract). Specifically, Branecky et al. teach sensor that detects a leading edge of a mailpiece and produces a signal to reset the counter (abstract; figure 6; column 5, lines 5-53). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of O'Callaghan et al. and Branecky et al. in order to prevent problems in accurately indicia ('429, column/line 1/28-2/12; column 2, lines 27-38; column 5, lines 13-22).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

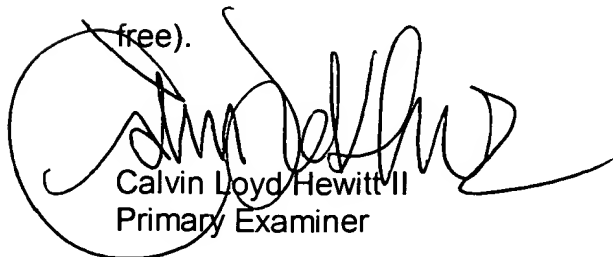
or faxed to:

(571) 273-8300 (for formal communications intended for entry and
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label
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free).



Calvin Loyd Hewitt II
Primary Examiner

April 27, 2006